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GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

PETERSON, KENNETH E

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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/696,643
Filing Date: October 29, 2003
Appellant(s): MICHEL ET AL.

MAILED
MAR 27 2007
GROUP 3700

Roger Greer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 January 07 appealing from the Office
action mailed 22 May 06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Claims 13,14 and 16 have been cancelled, so rejections thereagainst will not be discussed below.

(4) Status of Amendments After Final

Appellant is appealing a non-final rejection, which is permissible since the case has been thrice rejected. No amendments were received after the last non-final rejection.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is largely correct. Examiner notes that he is *not* relying on "unidentified patents", nor is Examiner relying on any type of Official Notice. All the teaching can be found in the

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prior art relied upon. Examiner further notes that he has dropped the Biek '282 reference since it was redundant.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,545,659	Ginter	March 1951
4,276,675	Pioch	July 1981
4,711,609	Seefluth	December 1987
5,755,293	Bourke	May 1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner notes that only features found in claim 1 are argued. Alltho Appellant mentions other claims, he provides no arguments unique to them. There are two independent claims, namely 1 and 19. All of the features of claim 1 can be found in claim 19, but not vice versa. Since the claims are argued as a group, it is assumed that the board will only be reviewing broadest claim 1 as per 37 CFR 41.37(c)(vii).

Accordingly, claims 2,3,5,6,19 and 20 will stand or fall with claim 1.

REJECTION #1 UNDER 35 USC 102

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Pioch '675. Claim 1 will be analyzed word by word (in bold) and discussed (in non-bold).

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A scroll collar - Pioch's elements 36 and 38 together form a scroll collar.

and a reciprocating tool assembly – Pioch's tool assembly (figure 1) is a hammer drill that reciprocates (lines 49,50, column 4).

for providing a rotating grip, - this intended use statement is met by Pioch, who has a rotating grip (32) on the scroll collar (36,38).

comprising: a reciprocating tool – Pioch's lines 49,50, column 4, as discussed above.

having a housing – Pioch has a housing (12).

and a working end – Pioch has a working end (at 22).

to which a reciprocating tool blade can be attached; - Pioch shows a drill bit (22) that is considered to be a tool blade, since it inherently has sharp edges and cuts material. Even if one was to consider that Pioch's bit 22 was not a "tool blade", then take note that this recitation is an intended use statement and the tool blade is not positively recited. Compare the employed phrase "can be attached" (no positive recitation) with an alternative phrase "is attached" (positive recitation). Even though this is an intended use statement, Examiner is giving it weight. The prior art to Pioch must be *capable* of attaching a reciprocating tool blade. Examiner's position is that hammer drills, such as Pioch's, are inherently *capable* of having a tool blade attached. Proof of this inherency can be seen in Seefluth '609, who shows a hammer drill with a tool blade attached thereto (e.g. figures 5 and 5B, lines 44-49, column 7). Of course, as per MPEP 2131.01 (III), it is permissible to have a second reference in a 102 rejection to show inherency. The providing of Seefluth is not considered to be a new grounds of

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rejection, since those of ordinary skill would have recognized the inherency when Examiner first set forth the rejection.

a support structure on said housing adjacent said working end; - the support structure is Pioch's barrel portion 20 (figure 4).

and a generally cylindrical scroll collar – Pioch's 36 and 38 as discussed above. Note the term "generally". The collar need not be perfectly cylindrical.

carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis. – Pioch discusses this rotating function on lines 5-20 of column 4. Examiner notes that the "tool blade" is mentioned again without being clearly positively recited. The tool blade is only mentioned within a "configured to" statement about another part. Again, Examiner posits that Pioch's drill bit constitutes a "tool blade" and furthermore that Pioch is *capable* of holding a tool blade as inherently seen in Seefluth.

In regards to claim 3 (not argued), Pioch's support structure is attached to the housing and has a generally circular interface as seen in figures 1 and 4.

REJECTION #2 UNDER 35 USC 103

Claims 1-3, 19 and 20 are rejected under 35 U.S.C. 103(a) over (Pioch '675 or Ginter '659) in view of Bourke '293.

It is well known for drills to have generally cylindrical collars rotatable around their gear housings. This can be seen in the hammer drill to Pioch (36,38) and the

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rotary drill to Ginter '659 (22). It is also well known for drills to be converted to reciprocating saws as seen in Bourke '293 (cover figure). It would have been obvious to one of ordinary skill in the art to have modified the likes of Pioch or Ginter by attaching the reciprocating saw conversion of the likes of Bourke, in order to be able to saw things without having to carry around a separate reciprocating saw power tool. The motivation for this attachment is best seen on Bourke's lines 22,23 of column 1, "thereby expanding the utility and versatility of cordless, electric or pneumatic power drills".

Claim 1 will be analyzed word by word (in bold) and discussed (in non-bold).

A scroll collar - Pioch's elements 36 and 38 together form a scroll collar.

Ginter shows a scroll collar (22).

and a reciprocating tool assembly – The Bourke attachment is a reciprocating tool assembly.

for providing a rotating grip, - this intended use statement is met by Pioch, who has a rotating grip (32) on the scroll collar (36,38). Ginter also shows a rotating grip (20) on the scroll collar (22).

comprising: a reciprocating tool – Bourke's attachment.

having a housing – Pioch has a housing (12). Ginter has a housing (10).

and a working end – Pioch has a working end (at 22). Ginter has a working end (right side of figure 2).

to which a reciprocating tool blade can be attached; - Bourke's attachment has a reciprocating tool blade (244, cover figure).

a support structure on said housing adjacent said working end; - the
support structure is Pioch's barrel portion 20 (figure 4). Ginter shows a support structure as well (area of groove 28).

and a generally cylindrical scroll collar – Pioch's 36 and 38 and Ginter's 22, as discussed above.

carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis. – Pioch discusses this rotating function on lines 5-20 of column 4. Ginter discusses it on lines 8-13, column 1.

In regards to claims 2 and 20 (not argued), Bourke's attachment shows a reciprocating saw blade (244, cover figure).

In regards to claim 3 (not argued), Pioch's support structure is attached to the housing and has a generally circular interface as seen in figures 1 and 4. Ginter's support structure is attached to the housing

In regards to claim 19 (not argued), the Bourke attachment constitutes a gear housing (see gears 256,260, cover figure) that is disposed adjacent to the motor housing and working end. This gear housing is secured to the support structure via the chuck 246.

REJECTION #3 UNDER 35 USC 103

Claims 5,6 (not argued) are rejected under 35 U.S.C. 103(a).

The devices set forth in the rejections above lack a resistance O-ring between the collar and the support structure. It is old and well known to employ resistance O-rings between two such objects, as seen in the patent to Phillips et al.'645 (153). It would have been obvious to one of ordinary skill in the art to have further modified the devices set forth above by adding a resistance O-ring between the collar and the support structure, as taught by Phillips, in order to prevent loose rotation and to compensate for manufacturing tolerances.

(10) Response to Argument

ARGUMENT #1 – 102 rejection by Pioch

Appellant argues that Pioch's handle "*is not intended to provide a rotating grip as set forth in the preamble of claim 1*". Examiner fails to see the point Appellant is making. Pioch's rotating grip is held during tool use. The question of whether or not he rotates the grip *during* tool use is an intended use question better claimed in a method claim.

Appellant argues on page 5 that Pioch has a drill bit, not a tool blade. Examiner's position is that a drill bit *is* a tool blade, and that the tool blade is never positively recited anyway, as discussed above. Pioch is most certainly *capable* of holding a tool blade, as evidenced by the Seefluth reference, discussed above. While this seems unnecessary, if the honorable board deems it wise for the office combine Pioch and Seefluth in a 103 rejection, then the board should feel free to remand the case to the Examiner, who will promptly add that rejection.

Appellant continues (pages 5 and 6) to discuss how his collar is used, but fails to point out structure in the claims not shown by Pioch.

ARGUMENT #2 – 103 rejection by Pioch, Ginter and Bourke

Appellant professes not to understand the rejection. While the combination of a common drill and a common drill attachment seems to need no clarification, Examiner

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has fleshed out the details for review above. Proper motivations were supplied in the final rejection and are discussed further above.

Appellant has not shown what the combination is missing, nor has he discussed any flaws in the given motivation.

On 09 January 07, Examiner had a chance to talk with the Appellant and further discuss the rejection, but Appellant chose to proceed with the appeal anyway.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ken Peterson

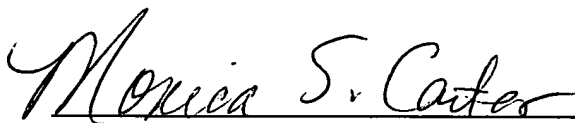
Conferees:



Supervisory Patent Examiner Boyer Ashley



KENNETH E. PETERSON
PRIMARY EXAMINER



Supervisory Patent Examiner Monica Carter